

Please Direct All Correspondence to Customer Number **20995**



PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant : Albertson, et al.
App. No : 10/728,693
Filed : December 5, 2003
For : CATEGORIZING FASTENERS AND
CONSTRUCTION CONNECTORS
USING VISUAL IDENTIFIERS
Examiner : Mitchell, Katherine W.
Art Unit : 3677

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants requests a pre-appeal brief review of the legal and factual basis of the rejections in the January 27, 2006 Office Action. Applicants' claims have been twice rejected, and as such Applicants may appeal the Examiner's decision to the Board of Patent Appeals and Interferences. No amendments are being filed with this request, and this request is being filed with a Notice of Appeal.

The Review is requested for the reason(s) stated on the attached sheets.

REASONS FOR REQUEST

In the January 27, 2006 Office Action, the Examiner finally rejected Claims 9, 90-94 and 96-98 under 35 U.S.C. § 103(a) as being unpatentable over Dickson USP 5,511,917 in view of Schwartz USP 5,181,439. In the January 27, 2006 Office Action, the Examiner also finally rejected Claims 92 and 95 under 35 U.S.C. § 103(a) as being unpatentable over Dickson USP 5,511,917 in view of Schwartz USP 5,181,439 and common knowledge in the art.

I. The Claims At Issue

Claims 9 and 90-98 are pending on appeal. Claim 9 is the only independent claim, and as amended, reads as follows:

A method of identifying the physical properties of an inserted fastener, comprising:

selecting a plurality of colors to apply to a portion of a fastener that is exposed then the fastener is inserted into an object, where each color connotes a different combination of at least two physical properties of the fastener;

applying one of said plurality of colors to the exposed surface of the fastener, so that the color may be recognized by a person of normal vision from a distance of at least 10 feet;

inserting the fastener into an object; and

providing a color key with the selected plurality of colors indicating the specific combination of at least two physical properties that each selected color connotes.

Claims 90-95 depend from Claim 9 and recite specific types of fasteners (nail, bolt, staple, rivet, screw and wedge anchor bolt). Claims 96-98 also depend from Claim 9 and recite a symbol, letter and number on the exposed surface to indicate a third physical property of the fastener.

All claims were rejected as being obvious over U.S. Patent No. 5,511,917 to Dickson ("Dickson") in view of U.S. Patent No. 5,181,439 to Schwartz ("Schwartz").

II. Summary Of Argument

The Examiner's rejection was erroneous for the following reasons:

- The cited art, alone or in combination, fails to disclose or suggest at least the following bolded limitations of Claim 9¹:
 - Selecting a plurality of colors . . . where **each color connotes a different combination of at least two physical properties of the fastener**
 - applying one of said plurality of colors to the exposed surface of the fastener, so that the **color may be recognized by a person of normal vision from a distance of at least 10 feet**
 - **providing a color key with the selected plurality of colors indicating the specific combination of at least two physical properties that each selected color connotes**
- Furthermore, the Examiner erred in finding motivation to combine Dickson with Schwartz to arrive at the claimed invention.

III. Argument

A. The cited art fails to disclose the claimed limitation of a single color corresponding to two physical properties

Dickson is directed to fasteners with multiple indicia on an exposed surface of a fastener to identify the length and gauge of the fastener. *See, e.g.*, Col. 2:8-24. Specifically, Dickson discloses the use of a first indicia to identify the gauge of a fastener and an additional two to three indicia to identify the length of the fastener. *See, e.g.*, Col. 3:65 – Col. 4:29 and Figures 1-2a-c. Accordingly, Dickson fails to disclose a single color used to identify two physical properties of a fastener, as is claimed in Claim 9 of the pending application.

Schwartz is equally deficient. Schwartz discloses coloring the head of a fastener and the corresponding tool used to insert and remove the fastener with the same color so that the appropriate tool may be selected more easily. *See, e.g.*, Abstract. The color relates only to one physical property, the cross-sectional diameter of the portion of the fastener engaged by the

¹ Because all other pending claims depend from Claim 9, for brevity, Applicants argue only the patentability of Claim 9 over the cited art. Applicants respectfully submit that if Claim 9 is found patentable, dependent Claims 90-98 are patentable as well.

corresponding colored tool, and the same color may be used to correspond to different diameters and thus different tools. *See, e.g.*, Col. 2:20-59.

B. The cited art fails to disclose the limitation that the colored exposed surface is recognizable from at least 10 feet away

Dickson fails to disclose that the indicia disclosed therein can be recognized from a distance of at least 10 feet away by a person of normal vision when the fastener is inserted. Indeed, referring to Figures 4 and 7 of Dickson, which disclose nail length, gauge and corresponding head size, it is unlikely that a person of normal vision could discern the identity and location of both indicia to accurately determine the length and gauge of the inserted fastener embodiments from a distance of 10 feet.

Schwartz, which discloses only coloring fasteners and tools the same color to facilitate tool selection, fails to disclose the claimed method of using a color identifiable from ten or more feet away to determine two physical properties of a fastener.

C. The cited art does not disclose a color key corresponding to a specific combination of two physical properties

Neither Dickson nor Schwartz teach or suggest a color key with the “selected plurality of colors indicating the specific combination of at least two physical properties” that each color connotes for an inserted fastener. The Examiner found that such a limitation “was inevitably taught by Dickson.” Office Action, January 27, 2006 at page 4. Yet it is clear that Dickson did not disclose colors to indicate physical properties, and Dickson used a single marking to connote a single property, which necessitated the use of two or more marks to designate at least two physical properties. Thus, Applicants respectfully submit that the cited art does not disclose the claimed color key limitation.

D. There is no motivation to combine the teachings of Dickson and Schwartz

The Examiner found that it would be obvious to modify Dickson as taught by Schwartz to color the tops of fasteners to improve visibility at a glance. It is respectfully submitted that modifying Dickson in view of Schwartz is not suggested and would result in a fastener lacking the properties of pending Claim 9.

First, Dickson requires two graphical markings (letters, numbers, geometrical shapes, tic marks, *see, e.g.*, Col. 4:31-36) to determine the length and gauge of the shaft of a fastener, while Schwartz discloses the use of a color to select the proper tool more easily to be used to insert and

remove the fastener. Thus, there is no motivation to apply Schwartz to Dickson, or vice versa, as they are directed to different problems.

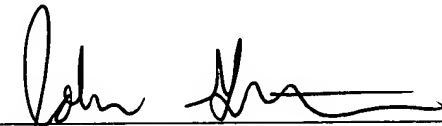
Moreover, Dickson counsels against using colors to form the multiple graphical markings needed to determine the length and gauge of the shaft. Dickson specifically states that graphical indicators which are inked or painted on the fastener may become illegible if the fastener is later painted, or may wear off if the fastener is inserted. *See, e.g.*, Col. 5:35-46. Accordingly, it is respectfully submitted that Dickson teaches away from the use of colors as graphical markings.

For at least the foregoing reasons, Applicants submit that Claims 9 and 90-98 are in condition for allowance, and Applicants respectfully request such action.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 7/26/06

By: 
John P. Giezantanner
Registration No. 39,993
Attorney of Record
Customer No. 20,995
(949) 760-0404